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Applicant: Michael P. Delaney

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REPLY BRIEF OF APPELLANT

This Reply Brief addresses issues raised in the Examiner's Answer mailed May 17, 2004.

The Examiner's Answer is responsive to Appellant's Appeal Brief filed March 4, 2004.

The Examiner has withdrawn the rejection of claims 14-15 and 24-25 (see Examiner's Answer, page 10, lines 6-8).

Issue 1

CLAIMS 1-10, 13, 16-21, AND 26-35 ARE NOT UNPATENTABLE UNDER 35 U.S.C. §103(a) OVER THEIMER (U.S. PATENT NO. 5,649,099) IN VIEW OF RACKMAN (U.S. PATENT NO. 5,903,646)

The Examiner rejected claims 1-10, 13, 16-21, and 26-35 under 35 U.S.C. §103(a) as allegedly being unpatentable over Theimer (U.S. Patent No. 5,649,099) in view of Rackman (U.S. Patent No. 5,903,646).

Claims 1, 16, and 29

Appellant's Appeal Brief provided the following first example of why Theimer in view of Rackman does not teach or suggest each and every feature of claims 1, 16, and 29, namely that neither Theimer nor Rackman teach or suggest the feature: "if the requested access is not security blocked, determining whether the data object includes a privileged communication (PCOM) between an attorney and a client of the attorney" (claim 1); "status means for making a determination as to whether the data object includes a privileged communication (PCOM) between an attorney and a client of the attorney" (claim 16); and "status software for making a determination as to whether the data object includes a privileged communication (PCOM) between an attorney and a client of the attorney" (claim 29).

As admitted by the Examiner, Theimer does not disclose anything about a PCOM (i.e., privileged communication) between an attorney and a client of the attorney. As to Rackman, the Examiner's has cited col. 7, lines 31-52 of Rackman which discloses that field 9 of the data record of FIG. 2 contains bits (CF1 and CF2) indicating who is to be permitted to look at a document (i.e., data object of claim 1) that is identified with the data record. Appellants maintain that the bits CF1 and CF2 do not indicate whether the document is a PCOM but rather denotes a level of confidentiality associated with the document. The level of confidentiality reflected by the bits CF1 and CF2 is not indicative of whether the document is a PCOM. For example, the document may reflect work product rather than a privileged attorney-client communication (see Rackman, col. 1, lines 19-22). In other words, an analysis of the bits CF1 and CF2 is incapable of determining whether the document is a PCOM as required by claims 1, 16, and 29, and is capable of only determining the level of confidentiality and associated access control to the

document.

The Examiner's Answer responded as follows to Appellant's first example: "Applicant's argument that the Rackman reference does not disclose whether the document contains a PCOM but rather discloses a level of confidentiality is not persuasive because Rackman discloses that the litigation documents in question are stamped with "Bates number" identifications which identify redacted portions of the documents as being irrelevant or privileged based on the grounds of attorney client privilege (Col. 1, lines 14-22), which is interpreted to indicate attorney client communication or PCOM. These "Bates number" identifications and subsequent redacted portions of the documents can indicate whether the portion in question is confidential or not (Col. 9, lines 51-62). These litigation documents may contain not only subject matter of a particular lawsuit, but also unrelated matters (Col. 1, lines 65-67). So it is desirable to redact portions of these documents that are considered privileged (Col. 2, lines 3-8)."

In Reply to the preceding argument by the Examiner, Appellant asserts that the Bates number stamp does not determine whether the Bates-stamped document includes a privileged communication (PCOM) between an attorney and a client of the attorney. As stated in col. 1, lines 14-22 of Rackman cited by the Examiner, the Bates stamp indicates only that content within the document is redacted because of irrelevancy, attorney-client privilege, or work-product immunity. Since attorney-client privilege is only one reason out three possible reasons disclosed by Rackman for the redacted content in the Bates-stamped document, it is logically impossible to determine from the presence of a Bates stamp that the document includes a PCOM between an attorney and a client of the attorney. As a further observation, Rackman discloses in col. 1, lines 20-22 "privileged logs (lists of documents which are being withheld on the grounds of attorney-

client privilege or work product immunity)". However, such a "list of documents" does not determine whether any of the listed documents include a PCOM., since the listed documents may alternatively have redacted material for reasons work-product immunity. Thus Appellant asserts that the Examiner has failed to establish a *prima facie* case of obviousness in relation to claims 1, 16, and 29.

In addition, the Examiner's Answer totally ignored the **conditional aspect** of the "determining" step in claim 1, namely the requirement in claim 1 that said "determining whether the data object includes a privileged communication (PCOM) between an attorney and a client of the attorney" is to be performed "**if the required access is not security blocked**" (emphasis added). The Examiner has not provided any citation in Theimer or Rackman that said "determining" is to be performed conditionally. Thus Appellant asserts that the Examiner has failed to establish a *prima facie* case of obviousness in relation to claim 1.

Appellant's Appeal Brief provided the following second example of why Theimer in view of Rackman does not teach or suggest each and every feature of claims 1, 16, and 29, namely that neither Theimer nor Rackman teach or suggest the feature: "if the data object includes the PCOM, deciding whether a PCOM message for the data object is to be published at the node; and if the PCOM message is to be published, publishing the PCOM message at the node" (claim 1). "publication means for publishing a PCOM message for the data object" (claim 16); and "publication software for publishing a PCOM message for the data object" (claim 29)

The Examiner's Answer responded as follows to Appellant's second example:
"Applicant's argument that the Rackman reference does not disclose publishing a PCOM

message if it is determined that a PCOM is included in the data object is not persuasive because Rackman discloses in Fig. 1 that a redacted document displays a confidentiality message (8b) when a portion of the document has been redacted. If we examine the figure further we see that redacted portion 8a is shown without a confidentiality message, while 8b contains both the confidentiality message along with its associated "Bates Number" (Col. 5, lines 5-27). This would indicate that a decision is made to publish a message and "Bates Number" at one portion of a document and not another."

In Reply to the preceding argument by the Examiner, Appellant asserts that the Examiner's argument is not persuasive, because "CONFIDENTIAL" as displayed in reference numeral 8b in FIG. 2 of Rackman does not imply a PCOM between an attorney and a client of the attorney, since the reason for said "CONFIDENTIAL" could be work-product immunity as explained in col. 1, lines 14-22 of Rackman.

In further Reply to the preceding argument by the Examiner, Appellant asserts that the Examiner's argument is not persuasive, because the Examiner has made the unsupported argument that "[The CONFIDENTIAL symbol] would indicate that a decision is made to publish a message and "Bates Number" at one portion of a document and not another." The Bates number appears in FIG. 1 of Rackman. However, as explained in Rackman (see Rackman, col. 4, lines 48-51 and further in col. 5, line 55 - col. 6, line 6), FIG. 1 in Rackman is only a page on an optical disk, and Rackman does not disclose publication of said page at the node as required by claims 1, 16, and 29. The Examiner has not cited anything in Rackman disclosing publishing the PCOM at a node. Thus, the Examiner has provided an argument without evidentiary support. Accordingly, Appellant asserts that the Examiner has failed to establish a *prima facie* case of

obviousness in relation to claims 1, 16, and 29.

Appellant's Appeal Brief provided the following third example of why Theimer in view of Rackman does not teach or suggest each and every feature of claims 1, 16, and 29, namely that the Examiner's argument for modifying Theimer with Rackman's disclosure of access control to litigation documents is not persuasive.

In the office action of September 9, 2003, the Examiner's argues: "It would have been obvious to one of ordinary skill in the art at the time the invention was made for the permission bits in Theimer to include an confidentiality field identifying that the file contains attorney client communications in order to provide a system for the distribution of confidential documents for attorney's as taught by Rackman (Col. 1, lines 29-59)".

In response, Appellant contends that Theimer is concerned with the controlled delegation of access rights from clients to untrusted intermediaries (see Theimer's Abstract) and accomplishes this objective with access control programs (ACPs) as disclosed in Theimer's abstract and throughout the Theimer disclosure. Rackman does not disclose anything that could be used in Theimer to improve Theimer's invention, inasmuch as the ACPs, as disclosed by Theimer, does everything that needs to be done to accomplish the objectives of Theimer's invention. Additionally, Theimer has no disclosed need specifically for access control to litigation documents, and most certainly has no disclosed need specifically for publishing a PCOM message. Therefore it is not obvious to modify Theimer with the teaching of Rackman as argued by the Examiner.

The Examiner's Answer responded as follows: "Applicant's argument that the motivation

to combine the Theimer and Rackman references is not persuasive because the Rackman reference does not disclose anything that could be used in Theimer to improve Theimer's invention is itself not persuasive because as mentioned in the original grounds of rejection, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the confidentiality permission bits disclosed in Rackman with the access rights of Theimer so that the users, including attorneys, may distribute confidential documents as taught by Rackman (Col. 1, lines 29-59). It is an improvement on the system of Theimer in that it expands the user realm to include attorneys by adding access rights to the current system.”.

In Reply to the preceding argument by the Examiner, Appellant asserts that the Examiner has not supplied a legally persuasive argument as to why a person of ordinary skill in the art would modify Theimer by the alleged teaching of Rackman in relation to claims 1, 16, and 29. In particular, established case law requires that the prior art must contain some suggestion or incentive that would have motivated a person of ordinary skill in the art to modify a reference or to combine references. See *Karsten Mfg. Corp. V. Cleveland Gulf Co.*, 242 F.3d 1376, 58 U.S.P.Q.2d 1286, 1293 (Fed. Cir. 2001 (“In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching **in the prior art** that would have led a person of ordinary skill in the art to select the references and combine them in a way that would produce the claimed invention”). See also *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984 (“The mere fact that the prior art could be so modified would not have made the motivation obvious **unless the prior art suggested the desirability of the modification.**”). The Examiner has not made any showing of where the prior art suggests modifying Theimer, which is concerned only with access control, “to include

an confidentiality field identifying that the file contains attorney client communications”. The Examiner has not cited even one prior art reference that teaches or suggests an integration of such access control with privileged attorney-client communication. Thus, the Examiner has provided a reason for the combination of references by the Examiner’s creative speculation, and not by teachings of the prior art. By not citing any suggestion or incentive in the prior art “to include an confidentiality field identifying that the file contains attorney client communications”, the Examiner has failed to establish a *prima facie* case of obviousness in relation to claims 1 and 16.

Based on the preceding arguments, Appellant respectfully maintains that claims 1, 16, and 29 are not unpatentable over Theimer in view of Rackman, and that claims 1, 16, and 29 are not in condition for allowance. Since claims 2-11 and 13-15 depend from claim 1, Appellant contends that claims 2-11 and 13-15 are likewise in condition for allowance. Since claims 17-22 and 24-28 depend from claim 16, Appellant contends that claims 17-22 and 24-28 are likewise in condition for allowance. Since claim 30 depends from claim 29, Appellant contends that claim 30 is likewise in condition for allowance.

Claim 2

Claim 2 claims the following combination of features: “sending a request from the node to the server for access of the data object by the node, ... deciding by a user at the node whether to abandon the request for said access; if deciding to abandon, user-abandoning the request; and if deciding not to abandon, user-electing not to abandon and enabling said access”. Note that claim 2 requires that the request-sending node both sends the request and abandons the request.

The Examiner’s Answer argues: “Theimer discloses the intermediary (node), after server

verification of rights, approving of the request (deciding to abandon or complete request)(Col. 18, lines 14-39)".

In Reply, Appellant contends that in Theimer, col. 18, lines 14-39, an intermediary node (I_i) sends the request to the server S and if the request is to be abandoned, it is the server S and not the intermediary node I_i who abandons the request as stated in Theimer col. 18, lines 38-39 ("S refuses to execute the request)". Hence, Theimer's disclosure does not satisfy the requirement in claim 2 that the request-sending node both sends the request and abandons the request.

The Examiner's Answer further argues: "Applicant's argument that the Theimer and Rackman references do not disclose abandoning the request for access of the data object by the user of the node is not persuasive because it is well known that all computer system processes can be ended or abandoned easily. In the Unix operating system that is used in the Theimer (Col. 5, lines 6-12 & Col. 19, lines 2427), users can end or abandon any computer process by using the kill command and the corresponding process identification (See Quick Reference: Unix Commands, Page 2). Further Rackman discloses that access to the confidential documents is controlled by the operating system (Col. 3, lines 22-23) therefore one of ordinary skill in the art would recognize the ability of a user to end or abandon their access request at any time."

In further Reply, Appellant contends that the preceding argument by the Examiner is not persuasive, since the Examiner has not overcome the preceding citation in Theimer, col. 18, lines 14-39 asserting that the server and not the intermediary node abandons the request. This is a key aspect of Theimer's access control scheme and therefore cannot be violated. Thus, the Examiner's suggested modification of Theimer would effectively destroy Theimer's invention.

In addition, the Examiner's allegation that a user could end or abandon a computer process is not an argument as to why it is obvious to modify Theimer's requirement that it is the server that abandon's a request.

Therefore claim 2 is not obvious over Theimer in view of Rackman.

Claim 4

Claim 4 claims the following feature: "wherein the step of deciding by a user includes selecting the user from the group consisting of the attorney and an attorney-affiliate who is authorized to access the data object". . In the office action of September 9, 2003, the Examiner argued: "Rackman discloses the users being clients, attorneys or proper counsel (attorney-affiliate)(Col. 7, lines 45-49)". In response, Appellant's Appeal Brief argued that the Examiner did not provided any argument as to why it is obvious to modify Theimer with the alleged teaching of Rackman with respect to the preceding feature of claim 4.

The Examiner's Answer alleges: "Applicant's argument that no motivation has been provided to modify Theimer with the teaching of Rackman with respect to the preceding feature of claim 4 is not persuasive because the motivation was given in the preceding independent claim. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the permission bits in Theimer to include an confidentiality field identifying that the file contains attorney client communications in order to provide a system for the distribution of confidential documents for attorney's as taught by Rackman (Col. 1, lines 29-59)."

In response, Appellant contends that the preceding allegation in the Examiner's Answer does not include an argument as to why is obvious to modify Theimer with the teaching of

Rackman with respect to the preceding feature of claim 4. The Examiner's Answer merely reiterated the argument provided by the Examiner for modifying Theimer with the teaching of Rackman with respect to the independent claim. The Examiner erroneously argues that motivation to modify Theimer with the teaching of Rackman with respect to the independent claim automatically provides motivation to modify Theimer with the teaching of Rackman with respect to claim 4, even though the pertinent feature of claim 4 is not included in the independent claim. Accordingly, since the Examiner has not provided any argument as to why it is obvious to modify Theimer with the alleged teaching of Rackman with respect to the preceding feature of claim 4, Appellant contends that the Examiner has not established a *prima facie* case of obviousness in relation to claim 4.

Claim 5

Claim 5 claims the following feature: "wherein the step of deciding by a user includes selecting the user from the group consisting of the client and a client-affiliate who is authorized to access the data object".

Appellants contend that the Examiner has not provided any argument as to why it is obvious to modify Theimer with the alleged teaching of Rackman with respect to the preceding feature of claim 5.

The Examiner's Answer alleges: "The motivation was given in the preceding independent claim. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the permission bits in Theimer to include a confidentiality field identifying that the file contains attorney client communications in order to provide a system for the distribution of

confidential documents for attorney's as taught by Rackman (Col. 1, lines 29-59)."

In response, Appellant contends that the preceding allegation in the Examiner's Answer does not include an argument as to why is obvious to modify Theimer with the teaching of Rackman with respect to the preceding feature of claim 5. The Examiner's Answer merely reiterated the argument provided by the Examiner for modifying Theimer with the teaching of Rackman with respect to the independent claim. The Examiner erroneously argues that motivation to modify Theimer with the teaching of Rackman with respect to the independent claim automatically provides motivation to modify Theimer with the teaching of Rackman with respect to claim 5, even though the pertinent feature of claim 5 is not included in the independent claim. Accordingly, since the Examiner has not provided any argument as to why is obvious to modify Theimer with the alleged teaching of Rackman with respect to the preceding feature of claim 5, Appellant contends that the Examiner has not established a *prima facie* case of obviousness in relation to claim 5.

Claim 6

Claim 6 claims the following feature: "wherein the user is not authorized to access the data object". Appellants contend that the Examiner has not provided an argument to establish that Theimer in view of Rackman teaches or suggests the preceding feature of claim 6.

The Examiner's Answer (as well as the office action of September 9, 2003) argues: "Applicant's argument that no argument was presented relating to the features of claim 6 is not persuasive because claim 6 was addressed with its independent claim (1). From the present rejections (Page 2, paragraph 3): The server authenticates (security blocked) the client and each

intermediary (Col. 9, lines 29-37). Requests are made from client or intermediaries to the server for a file (Col. 10, lines 1420). The server then verifies (deciding to publish) that the client or intermediaries have the permission to perform this request. This meets the limitation of wherein the user is not authorized to access the data object.”

In response, Appellant contends that the preceding argument in the Examiner’s Answer does not establish that Theimer discloses the feature: “wherein the user is not authorized to access the data object”. Rather, the preceding argument in the Examiner’s Answer merely alleges that Theimer teaches that “[t]he server then verifies (deciding to publish) that the client or intermediaries have the permission to perform this request”, which does not imply that “the user is not authorized to access the data object”.

Accordingly, Appellant contends that the Examiner has not established a *prima facie* case of obviousness in relation to claim 6.

Claims 7 and 18

Claims 7 and 18 claims the following features: “wherein the providing step further includes providing an input from the attorney as to whether the data object includes the PCOM, and wherein the determining includes a dependence on said input” (claim 7) and “wherein the status means includes a dependence on an input from the attorney as to whether the data object includes the privileged communication” (claim 18).

Appellant contends that Theimer in view of Rackman does not teach or suggest the preceding feature of claims 7 and 18. Moreover, Appellants contend that the Examiner has not provided any argument as to why it is obvious to modify Theimer with the alleged teaching of

Rackman with respect to the preceding feature of claims 7 and 18.

The Examiner's Answer argues: "Applicant's argument that the Rackman reference does not disclose providing an input from the attorney as to whether the data object includes the PCOM, and wherein the determining includes a dependence on said input is not persuasive because Rackman discloses that the stamping and identification of the privileged portions of the documents is done by legal assistants and attorneys (Col. 1, lines 16-27). The stamping and identification would meet the limitation of an input that determines whether the document in question contains a PCOM."

In response, Appellant contends that the preceding argument in the Examiner's Answer does not establish that Rackman discloses the preceding feature of claims 7 and 18, since the Bates stamp does not imply that the document contains a PCOM as explained *supra* in conjunction with claims 1 and 16.

Moreover, Appellant contends that the preceding argument in the Examiner's Answer merely alleges what Rackman discloses, but does not provide any argument as to why it is obvious to modify Theimer with the teaching of alleged Rackman with respect to the preceding feature of claims 7 and 18. Accordingly, Appellant contends that the Examiner has not established a *prima facie* case of obviousness in relation to claims 7 and 18.

Claims 8 and 19

Claims 8 and 19 claim the following features: "wherein the providing step further includes ascertaining whether the data object includes a phrase in a search list, and wherein the determining includes a dependence on a result of said ascertaining" (claim 8) and "wherein the

status means includes a dependence on a result of a keyphrase search for determining whether the data object includes a phrase in a search list” (claim 19).

Appellant contends that Theimer in view of Rackman does not teach or suggest the preceding feature of claims 8 and 19. Moreover, Appellants contend that the Examiner has not provided any argument as to why it is obvious to modify Theimer with the alleged teaching of Rackman with respect to the preceding feature of claims 8 and 19.

The Examiner’s Answer alleges: “Applicant’s argument that the Rackman reference does not disclose ascertain whether the data object includes a phrase in a search list, and wherein the determining includes a dependence on a result of said ascertaining is not persuasive because Rackman disclose that the scanned using optical character recognition so as to identify a particular name or subject matter and the stamping and identification of a subsequent match (Col. 1, lines 33-54), which meets the limitation of ascertaining whether the data object includes a phrase in a search list, and wherein the determining includes a dependence on a result of said ascertaining.”

In response, Appellant contends that the preceding argument in the Examiner’s Answer does not establish that Rackman discloses the preceding features of claims 8 and 19, since the Examiner’s citation of Rackman does not disclose or discuss a search list. The preceding citation of Rackman merely discloses that “there can be displayed successive images of pages all of which mention a particular person by name” (see Rackman, col. 1, lines 50-51) which has nothing to do with a search list.

Moreover, Appellant contends that the preceding argument in the Examiner’s Answer merely alleges what Rackman discloses, but does not provide any argument as to why it is

obvious to modify Theimer with the alleged teaching of Rackman with respect to the preceding feature of claims 8 and 19. Accordingly, Appellant contends that the Examiner has not established a *prima facie* case of obviousness in relation to claims 8 and 19.

Claims 9 and 20

Claim 9 claims the following feature: “wherein the determining step includes **always** determining that the data object includes the PCOM” (claim 9) and : “wherein the status means **always** determines that the data object includes the PCOM” (claim 20).

Appellant contends that Theimer in view of Rackman does not teach or suggest the preceding features of claims 9 and 20. Moreover, Appellants contend that the Examiner has not provided any argument as to why it is obvious to modify Theimer with the alleged teaching of Rackman with respect to the preceding feature of claims 9 and 20.

The Examiner’s Answer alleges: “Applicant’s argument that the Rackman reference does not disclose always determining that the data object includes the PCOM is not persuasive because Rackman discloses that when a document is being accessed the confidentiality bits are read to determine whether or not the user has access to the privileged information (Col. 3, line 30 - Col. 4, line 30). Which meets the limitation of always determining that the data object includes a PCOM.”

In response, Appellant contends that the preceding argument in the Examiner’s Answer does not establish that Rackman discloses the preceding feature of claims 9 and 20, since the preceding argument in the Examiner’s Answer does not establish the “always” limitation in claims 9 and 20.

Moreover, the preceding argument in the Examiner's Answer merely alleges what Rackman discloses, but does not provide any argument as to why it is obvious to modify Theimer with the alleged teaching of Rackman with respect to the preceding feature of claims 9 and 20. Accordingly, Appellant contends that the Examiner has not established a *prima facie* case of obviousness in relation to claims 9 and 20.

Claims 10 and 21

Claims 10 and 21 claim the following features: "wherein the publishing step includes visually displaying the PCOM message" (claim 1) and "wherein the publication means includes means for generating a visual display of the PCOM message" (claim 21).

Appellant contends that the Examiner has not provided any argument as to why it is obvious to modify Theimer with the alleged teaching of Rackman with respect to the preceding features of claims 10 and 21.

The Examiner's Answer alleges: "Applicant's argument that the Rackman reference does not disclose visually displaying a PCOM message is not persuasive because Rackman discloses in Fig. 1 that a redacted document displays a confidentiality message (8b) when a portion of the document has been redacted. If we examine the figure further we see that redacted portion 8a is shown without a confidentiality message, while 8b contains both the confidentiality message along with its associated "Bates Number" which are displayed visually (Col. 5, lines 5-27). The motivation to combine was given in the preceding independent claim. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the permission bits in Theimer to include a confidentiality field identifying that the file contains attorney client

communications in order to provide a system for the distribution of confidential documents for attorney's as taught by Rackman (Col. 1, lines 29-59).”

In response, Appellant contends that the preceding allegation in the Examiner’s Answer does not include an argument as to why is obvious to modify Theimer with the teaching of Rackman with respect to the preceding features of claims 10 and 21. The Examiner’s Answer merely reiterated the argument provided by the Examiner for modifying Theimer with the teaching of Rackman with respect to the independent claim. The Examiner erroneously argues that motivation to modify Theimer with the teaching of Rackman with respect to the independent claim automatically provides motivation to modify Theimer with the teaching of Rackman with respect to claims 10 and 21, even though the pertinent features of claims 10 and 21 are not included in the independent claim. Accordingly, since the Examiner has not provided any argument as to why is obvious to modify Theimer with the alleged teaching of Rackman with respect to the preceding feature of claims 10 and 21, Appellant contends that the Examiner has not established a *prima facie* case of obviousness in relation to claims 10 and 21.

Claim 13

Claim 13 claims the following feature: “wherein the deciding step includes a dependence on a decision variable”. Appellant notes that the Examiner has not presented any argument relating to the preceding feature of claim 13. Appellant contends that Theimer in view of Rackman does not teach or suggest the preceding feature of claim 13. Moreover, Appellants contend that the Examiner has not provided any argument as to why it is obvious to modify Theimer with the alleged teaching of Rackman with respect to the preceding feature of claim 13.

The Examiner's Answer alleges: "Applicant's argument that the Rackman references does not disclose a deciding whether of not to publish a PCOM message is not persuasive because Rackman discloses in Fig. 1 that a redacted document displays a confidentiality message (8b) when a portion of the document has been redacted. If we examine the figure further we see that redacted portion 8a is shown without a confidentiality message, while 8b contains both the confidentiality message along with its associated "Bates Number" which are displayed visually (Col. 5, lines 5-27). This would indicate that a decision is made to publish a message and "Bates Number" at one portion of a document and not another."

In response, Appellant contends that the preceding argument in the Examiner's Answer does not establish that Rackman discloses the preceding feature of claim 13, since the preceding argument in the Examiner's Answer does not provide a citation in Rackman for the "decision variable" of claim 13. In fact, the preceding argument in the Examiner's Answer does not even allege that Rackman discloses the "decision variable" of claim 13.

Moreover, the preceding argument in the Examiner's Answer merely alleges what Rackman discloses, but does not provide any argument as to why it is obvious to modify Theimer with the alleged teaching of Rackman with respect to the preceding feature of claim 13. Accordingly, Appellant contends that the Examiner has not established a *prima facie* case of obviousness in relation to claim 13.

Claims 17, 30, and 32

Claims 17, 30, and 32 claim the following features: "election means for deciding whether to abandon a prior request for the access; and enabling means for enabling the access" (claim 17);

“election software for deciding whether to abandon a prior request for the access; and enabling software for enabling the access to the data object” (claim 30); and “election means for deciding whether to abandon a prior request for the access, after execution of the publication means; and enabling means for enabling the access to the data object, after execution of the election means” (claim 32).

Appellant contends that the Examiner has not provided any argument as to why it is obvious to modify Theimer with the alleged teaching of Rackman with respect to the preceding features of claims 17, 30, and 32.

The Examiner’s Answer alleges: “Applicant’s argument that no motivation was given in claim 17 to combine the Theimer and Rackman references is not persuasive. The motivation to combine was given in the preceding independent claim. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the permission bits in Theimer to include a confidentiality field identifying that the file contains attorney client communications in order to provide a system for the distribution of confidential documents for attorney’s as taught by Rackman (Col. 1, lines 29-59).”

In response, Appellant contends that the preceding allegation in the Examiner’s Answer does not include an argument as to why is obvious to modify Theimer with the teaching of Rackman with respect to the preceding feature of claims 17, 30, and 32. The Examiner’s Answer merely reiterated the argument provided by the Examiner for modifying Theimer with the teaching of Rackman with respect to the independent claim. The Examiner erroneously argues that motivation to modify Theimer with the teaching of Rackman with respect to the independent claim automatically provides motivation to modify Theimer with the teaching of Rackman with

respect to claims 17, 30, and 32, even though the pertinent features of claims 17 and 30 are not included in the independent claim. Accordingly, since the Examiner has not provided any argument as to why is obvious to modify Theimer with the alleged teaching of Rackman with respect to the preceding features of claims 17, 30, and 32, Appellant contends that the Examiner has not established a *prima facie* case of obviousness in relation to claims 17, 30, and 32.

Claim 26

Since claim 26 depends from claim 24, and since the Examiner has withdrawn the rejection of claim 24, Appellants contend that the rejection of claim 26 must also be withdrawn.

Claim 27

Claim 27 claims the following feature: “a server coupled to the data object; an attorney node coupled to the server, for enabling the attorney to interact with the data object; and a client node coupled to the server, for enabling the client to interact with the data object.” Appellant contends that the Examiner has not provided any argument as to why it is obvious to modify Theimer with the alleged teaching of Rackman with respect to the preceding feature of claim 27.

The Examiner’s Answer alleges: “Applicant’s argument that the Theimer and Rackman references do not disclose a server coupled to the data object, an attorney node coupled to the server for enabling the attorney to interact with the data object, and a client node coupled to the server for enabling the client to interact with the data object is not persuasive because the Theimer reference discloses a server that can be a file server containing a resource (Col. 8, lines 30-53), which meets the limitation of a server coupled to a data object. The server can be coupled

to multiple clients (Col. 8, lines 61-67), and as noted earlier it would have been obvious to one of ordinary skill in the art at the time the invention was made for the to include the confidentiality permission bits disclosed in Rackman with the access rights of Theimer so that the users, including attorneys, may distribute confidential documents as taught by Rackman (Col. 1, lines 29-59). It is an improvement on the system of Theimer in that it expands the user realm to include attorneys by adding access rights to the current system. Therefore it would have been obvious that one of the clients could be an attorney since the improvement to Theimer is made to include attorneys as clients in the system.”

In response, Appellant contends that the preceding allegation in the Examiner’s Answer does not include an argument as to why is obvious to modify Theimer with the teaching of Rackman with respect to the preceding feature of claim 27. The Examiner’s Answer again merely reiterated the argument provided by the Examiner for modifying Theimer with the teaching of Rackman with respect to the independent claim. The Examiner erroneously argues that motivation to modify Theimer with the teaching of Rackman with respect to the independent claim automatically provides motivation to modify Theimer with the teaching of Rackman with respect to claim 27, even though the pertinent feature of claim 27 is not included in the independent claim. Accordingly, since the Examiner has not provided any argument as to why is obvious to modify Theimer with the alleged teaching of Rackman with respect to the preceding feature of claim 27, Appellant contends that the Examiner has not established a *prima facie* case of obviousness in relation to claim 27.

Claim 31

Claim 31 is similar to claim 16, the essential difference being that claim 31 is directed to a PCOM between a first person and a second person, whereas claim 16 is directed to a PCOM between an attorney and a client of the attorney. However, since the references of Theimer in view of Rackman cited by the Examiner allegedly disclose a PCOM only between an attorney and a client of the attorney, and do not disclose a PCOM between any two other classes of persons or parties. Accordingly, all arguments presented *supra* by Appellant in relation to claim 16 apply likewise to claim 31 with respect to the rejection over Theimer in view of Rackman. Accordingly, Appellant contends that claim 31 is not unpatentable over Theimer in view of Rackman.

Based on the preceding arguments, Appellant respectfully maintains that claim 31 is not unpatentable over Theimer in view of Rackman, and that claim 31 is in condition for allowance. Since claims 32-35 depend from claim 31, Appellant contends that claims 32-35 are likewise in condition for allowance.

Claims 33-35

Claims 33, 34, and 35 claim the following features: “wherein the PCOM between a first person and a second person includes a PCOM between a psychotherapist and a client of the psychotherapist” (claim 33); “wherein the PCOM between a first person and a second person includes a PCOM between a physician and a patient of the physician” (claim 34); and “wherein the PCOM between a first person and a second person includes a PCOM between a husband and a wife of the husband” (claim 35).

Appellant contends that the Examiner has not provided a legally persuasive argument as

to why it is obvious to modify Theimer with the alleged teaching of Rackman with respect to the preceding features of claims 33-35.

The Examiner's Answer argues: "Applicant's argument that the Examiner has not addressed whether it would be obvious to have status means for making a determination as whether the data object includes a PCOM between a psychotherapist and a client of the psychotherapist is not persuasive because in view of the current combination of Theimer and Rackman the combined system makes it possible to determine whether a document contains privileged communication between an attorney and a client and the Examiner stated that it would have been obvious for the communications within the files to be between any set of persons whom would want their communications kept confidential. Therefore communications involving a psychotherapist and a client of the psychotherapist would be obvious since communications of this distinction are considered confidential by law the same way attorney-client communications are considered confidential."... Applicant's argument with regards to PCOM between physician and a patient of the physician is not persuasive based on the reasoning directly above... Applicant's argument with regards to PCOM between a husband and a wife is not persuasive based on the reasoning directly above."

In response, Appellant notes that the preceding analysis by the Examiner has no basis in the prior art and is the product of the Examiner's creative imagination. For example, Appellant contends that the Examiner's assertion that "communications involving a psychotherapist and a client of the psychotherapist would be obvious since communications of this distinction are considered confidential by law the same way attorney-client communications are considered confidential" is incorrect and Appellant has provides no evidence to support this assertion. As

explained *supra* in conjunction with claim 1, 16, and 29, the Examiner is required to support a combination of reference by evidence derived from the prior art. Appellant notes that the Examiner has not cited any prior art reference that refers to communications between: a psychotherapist and a client of the psychotherapist; a physician and a patient of the physician; and a husband and a wife of the husband. Thus, the Examiner has not based arguments for claims 33-35 on teachings from the prior art as required by case law. In the absence of providing such support from the prior art, the Examiner has failed to establish a *prima facie* case of obviousness in relation to claims 33-35.

Issue 2

CLAIMS 11 AND 22 UNDER ARE NOT UNPATENTABLE UNDER 35 U.S.C. §103(a) OVER THEIMER (U.S. PATENT NO. 5,649,099) IN VIEW OF RACKMAN (U.S. PATENT NO. 5,903,646), AND FURTHER IN VIEW OF KEITHLEY (U.S. PATENT NO. 5,584,025)

The Examiner rejected claims 11 and 22 under 35 U.S.C. §103(a) as allegedly being unpatentable over Theimer (U.S. Patent No. 5,649,099) in view of Rackman (U.S. Patent No. 5,903,646), and further in view of Keithley (U.S. Patent No. 5,584,025).

Appellant contends that Theimer in view of Rackman does not teach or suggest the following feature of claims 11 and 22: “wherein the publishing step includes articulating the PCOM message by sound” (claim 11); and “wherein the publication means includes means for generating an audio articulation of the PCOM message” (claim 22).

The Examiner’s Answer argues: “Applicant’s argument that the motivation to combine that Theimer, Rackman, and Keithley references is an improper modification is not persuasive because Rackman discloses that confidentiality message, in text format, can be included on redacted portions of a document (Fig. 1), but Rackman does not disclose that the confidentiality message is in an audio format. Keithley discloses a server that distributes multimedia wherein an end user (client) can be delivered messages in an audio format (Col. 9, lines 51-59). It would have been obvious to one of ordinary skill in the art at the time the invention was made for the text warnings of Rackman to be audio because audio warnings are just as well known in the art as text warnings. In fact most text based warning messages for all Windows operating systems are accompanied by an audio sound”.

Appellant respectfully maintains that the preceding argument in the Examiner’s Answer

with respect to Keithly is an improper modification of the secondary reference of Rackman. The Examiner argues that the primary reference of Theimer discloses a method for delegating access rights through intermediaries and access control programs (ACPs). The Examiner also argues that the secondary reference of Rackman has modified the primary reference of Theimer, by alleging that Rackman teaches or suggests PCOMs and PCOM messages. The Examiner additionally argues that the secondary reference of Keithly has modified the secondary reference of Rackman, by alleging that Keithly teaches or suggests that the PCOM message could be articulated by sound. Appellant maintains that it is improper to argue that a claim feature is taught or suggested by a secondary reference through modification of another secondary reference. If the Examiner could modify a secondary reference in the preceding manner, then the Examiner would be able to show the existence of any element or feature of any claim merely by chaining a sufficient number of secondary references together in the preceding manner. Accordingly, Appellant respectfully maintains that the rejection of claim 11 and 22 under 35 U.S.C. §103(a) is improper and should be reversed.

SUMMARY

In summary, Appellant respectfully requests reversal of the September 9, 2003 Office Action rejection of claims 1-11, 13, 16-22, and 26-35. The Examiner has withdrawn the rejection of claims 14-15 and 24-25.

Respectfully submitted,



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